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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.: 10/651,205 Confirmation No.: 7628
Applicant: Johnson et al.
Filed: August 29, 2003
TC/A.U.: 3632
Examiner: R. Ramirez
Docket No.: 45088
Customer No.: 01609
For: BRACE ASSEMBLY FOR CEILING FANS AND FIXTURES

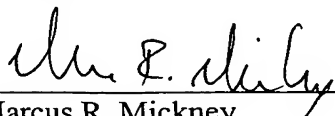
LETTER REGARDING REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In view of the revised Examiner's Answer filed with December 12, 2005, a courtesy copy of the Reply Brief filed August 3, 2005 is attached hereto. The Reply Brief was filed in response to the first Examiner's Answer filed June 3, 2005, which was ordered to be returned to the examiner such that a revised Examiner's Answer in compliance with the new rules could be issued. A copy of the communication indicating that the August 3, 2005 Reply has been entered and considered is enclosed.

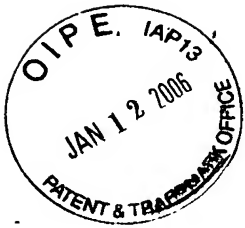
Respectfully submitted,



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REPLY BRIEF UNDER 37 CFR § 1.193(b)(1)

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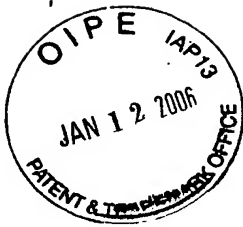


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REPLY BRIEF UNDER 37 CFR § 1.193(b)(1)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

For the appeal to the Board of Patent Appeals and Interferences from the decision of October 8, 2004 rejecting claims 1 – 16, 18 – 21 and 29 - 30 in the above-identified application, Appellant submits the following reply brief in response to the Examiner's Answer of June 3, 2005 in accordance with 37 C.F.R. § 1.193(b)(1).

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Reply to Examiner's Answer of June 3, 2005

I. Real Party in Interest

There is no dispute as to the real party in interest.

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II. Related Appeals and Interferences

There is no dispute as to related appeals and interferences.

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III. Status of Claims

There is no dispute as to the status of the claims.

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IV. Status of Amendments

There is no dispute as to the status of amendments after final rejection.

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V. Summary of the Claimed Subject Matter

There is no dispute as to the summary of the claimed subject matter.

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VI. Grounds of Rejection on Appeal

There is no dispute as to the grounds of rejection on appeal.

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VII. Claims Appealed

There is no dispute as to the copy of the appealed claims contained in the Appendix to Appellants' Appeal Brief.

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VIII. Prior Art of Record

There is no dispute as to the listing of the prior art of record.

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IX. Grounds of Rejection

In the Examiner's Answer, the Examiner maintains the rejections of the pending claims.

Claims 1, 3, 5 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,967,990 to Rinderer.

Claim 2 is rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,967,990 to Rinderer.

Claims 4, 8 – 16, 20, 21, 29 and 30 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,967,990 to Rinderer in view of U.S. Patent No. 4,050,603 to Harris et al.

Claim 6 is rejected under 35 U.S.C. § 103(a) as obvious under U.S. Patent No. 4,967,990 to Rinderer; in view of U.S. Patent No. 5,040,316 to Fast.

Claims 18 – 21 are rejected under 35 U.S.C. § 103(a) as obvious under U.S. Patent No. 4,967,990 to Rinderer in view of U.S. Patent No. 4,050,603 to Harris et al. and in further view of U.S. Patent No. 5,040,316 to Fast.

X. Reply to Examiner's Response to Appellants' Arguments

The claimed invention is directed to a brace assembly to support an electrical box. The embodiments of the present invention provide a brace assembly that is temporarily secured between supports without tools. For the reasons discussed herein, the art of record does not disclose or suggest the features of the present invention. Therefore, claims 1 – 16, 18 – 21 and 29 - 30 are patentable over the art of record.

This Reply Brief is being filed to respond to several incorrect statements made in the Examiner's Answer. Contrary to the assertion on page 6 of the Examiner's Answer, U.S. Patent No. 4,967,990 to Rinderer (the Rinderer patent) does not disclose or suggest a compression fit. Furthermore, the Rinderer patent does not disclose a mounting surface having a fastener hole and a flange extending perpendicularly outwardly therefrom. Finally, contrary to the Examiner's assertion on page 7 of the Examiner's Answer, U.S. Patent No. 5,040,316 (the Fast patent) is non-analogous art, such that the rejection based on modifying the Rinderer patent in view of the Fast patent is improper.

A. U.S. Patent No. 4,967,990 to Rinderer Does Not Disclose a Compression Fit

On page 6 of the Examiner's Answer, it is alleged that the Rinderer patent provides a compression fit and that "the strength of such fit would depend from the distance between the studs." However, there is no suggestion or motivation in the Rinderer patent to use the Rinderer brace assembly to obtain a compression fit between the vertical wall studs. As is clearly shown in FIG. 2, the fastening flaps 53 are secured by fasteners 57 to upper surfaces of the vertical wall studs. The fastening flaps 53 resting on the upper surfaces of the vertical wall studs prevent the Rinderer brace assembly from falling through the gap between the

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vertical wall studs prior to insertion of the fasteners 57, such that a compression fit is not needed to secure the Rinderer brace assembly in place. Thus, there is no reason or motivation to create a compression fit between the Rinderer brace assembly and the vertical wall studs.

However, contrary to the Rinderer brace assembly, Applicants' brace assembly is secured to lower surfaces of the vertical wall studs, as shown in FIGS. 1 and 2. Therefore, a compression fit must be formed between Applicants' brace assembly and the vertical wall studs to secure the brace assembly between the vertical wall studs without requiring the brace assembly to be held in place by tools or the installer prior to insertion of fasteners through the brace assembly and into the vertical wall studs.

The examiner further alleges that a contact area exists between the Rinderer extensions 51 and the inner side surfaces of the vertical wall studs, as indicated by the figure included on page 6 of the Examiner's Answer. However, independent claim 1 recites that the mounting surface is "adapted to create a compression fit by contacting the first support member when installed." While there may be contact between the Rinderer extensions 51 and the inner side surfaces of the vertical wall studs, such contact is merely incidental as it is the result of having mounting flanges secured to an upper surface of the vertical wall studs being connected to the bar 21 of the brace assembly by the downwardly extending extensions 51. Because the Rinderer extensions 51 extend downwardly to the bar 21 of the brace assembly from the fastening flaps 53, incidental contact occurs with the inner sides of the vertical wall studs near the upper surface thereof. Such contact is not intended to nor does it function to create a compression fit between extensions 51 and the vertical wall studs.

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Therefore, the Rinderer patent does not disclose or suggest forming a compression fit between a mounting surface of the brace assembly and a support member as recited in independent claims 1, 8 and 29.

B. U.S. Patent No. 4,967,990 to Rinderer Does Not Disclose a Flange Extending Perpendicularly Outwardly from the First Mounting Surface

It is further alleged that the first mounting surface, which is adapted to create a compression fit by contacting the first support member as recited in independent claim 1, has a first flange extending perpendicularly outwardly from the first mounting surface. However, if the first mounting surface is taken to be the Rinderer extension 51 and the flange 53 as indicated by the Examiner with respect to independent claim 1 (which it must if the first mounting surface is to have a first fastener hole as recited in independent claim 1), then the Rinderer patent does not disclose a flange extending perpendicularly outwardly from the first mounting surface as recited in dependent claims 5, 13, 14, 20 and 21. Therefore, the Rinderer patent does not disclose all the features recited in dependent claims 5, 13, 14, 20 and 21.

C. U.S. Patent No. 5,040,316 to Fast is Non-Analogous Art

The Examiner contends that the Fast patent is analogous art simply because the Fast patent discloses an adjustable bracket. As noted on page 14 of Appellants' Brief, "[t]he combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight is insufficient to present a prima facie case of obviousness." In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Merely because the Fast patent discloses a bracket, does not automatically result in the Fast patent being analogous art. Two criteria are relevant in determining whether prior art is analogous: (1) whether the art is from the same field of endeavor regardless of the problem

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addressed; and (2) if the art is not within the same field of endeavor, whether it is still reasonably pertinent to the particular problem to be solved. Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

The Fast patent is directed to a product display tag for use with support hooks (col. 1, lines 15 – 17). Applicants' invention relates to a brace assembly for ceiling fans and fixtures. Clearly, product display tags and brace assemblies for ceiling fans and fixtures are from different fields of endeavor. One skilled in the art would not look to the field of product display tags when attempting to solve problems associated with brace assemblies for electrical fans and fixtures.

The problem being addressed by the Fast patent is an adjustable length tag 10 that can be used with hooks 32 of various lengths (col. 1, lines 31 – 37). Applicants' invention is directed to a brace assembly temporarily securable between supports without tools and having adjustable mounting surfaces to accommodate various wall thicknesses (paragraphs 8 and 41). The problem being addressed by the Fast patent is clearly not reasonably pertinent to solving the problem associated with providing a brace assembly having adjustable mounting surfaces to accommodate various wall thicknesses when installing an electrical box.

Therefore, the Fast patent is non-analogous art and its combination with the Rinderer patent is improper.

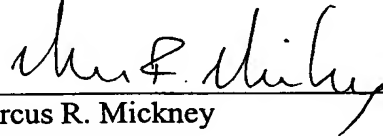
D. Conclusion

For the reasons presented herein, Applicants submit that claims 1 – 16, 18 – 21 and 29 – 30 are not anticipated under 35 U.S.C. § 102(b) or rendered obvious under 35 U.S.C. §

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103(a) by the cited references of record. Accordingly, reversal of the final rejection is requested and allowance of claims 1 – 16, 18 – 21 and 29 – 30 is respectfully requested.

Respectfully submitted,



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Dated: AUGUST 3, 2005



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,205	08/29/2003	Steven J. Johnson	45088	7628

1609 7590 08/19/2005

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EXAMINER

RAMIREZ, RAMON O

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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ROYLANCE, ABRAMS
BERDO & GOODMAN, L.L.P.
BY RSW



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Commissioner for Patents
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Reply Brief

The reply brief filed Aug 8, 2008 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMON O. RAMIREZ whose telephone number is (571) 272-6821. The examiner can normally be reached on MONDAY-FRIDAY, IST FRIDAY OFF.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor ROBERT OLSZEWSKI, can be reached on (571) 272-6788.

The fax phone number for the organization where this application or proceeding is assigned is 571 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ROR
Aug. 18, 05


RAMON O. RAMIREZ
Primary Examiner
Art Unit 3632

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